| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/699,517 | 10/31/2000 | Timothy A. McDonough | 03797.00007 | 7863 |

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| ART UNIT | PAPER NUMBER |
|---|---|
| 2677 | |

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/699,517 | MCDONOUGH ET AL. |
| | Examiner | Art Unit | |
| | Abbas I. Abdulselam | 2677 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on *25 May 2005*.

2a)☐ This action is **FINAL**.      2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) *17,18 and 33-50* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17,18 and 33-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

1.      Claims 17-18 and 33-50 are pending. In view of an interview conducted on 05/25/05, the

following non-final action is issued.

### *Claim Rejections - 35 USC § 112*

2.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention. Claim 52 from which claim 34 depends is not on the list of claims.

### *Claim Rejections - 35 USC § 103*

3.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 33-36 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kreisel et al. (USPN 6088516) in view of Stanek (USPN 5936554).

Regarding claim 35, Kreisel teaches a computer –readable medium having computer-

executable instructions for performing steps comprising: (communication package (3) including

memory containing incoming queue (23) and outgoing queue (25), col. 3, lines 14-17 and Fig.

1(b)) determining, in a computer, whether a predetermined event has occurred; (Fig. 1(b) and

col. 3, lines 18-21, email message) and communicating with a computer input device having an

illumination member to cause the illumination member to change in response to the determining

step, (inform a user when new mail messages are received by flashing one of the LEDs (17, 21)

upon the keyboard (15), col. 8, lines 38-46).

Kreisel does not teach a communicating step includes causing the illumination member to

change intensity.

Stanek (USPN 5936554) on the other hand teaches a computer program, whereby a

computer 96 instructs a keyboard controller of keyboard 98 via communications link 100 to

illuminate particular keys and dim other keys (Fig. 8 (98) and col. 8, lines 14-28).

Therefore, it would have been obvious to on of ordinary skill in the art at the time the

invention was made to modify Kreisel's computer system (terminal), (2) shown in Fig. 1b to

adapt Stanek's computer program with respect to keyboard illumination as demonstrated in Fig.

8 because the use of a program with respect to keyboard illumination helps establish has a bi-

directional communication link between a keyboard and a computer as taught by Stanek (col. 4,

lines 62-67).

Regarding claims 33-34, Stanek teaches the computer input device is a track-mouse

device (col. 3, lines 60-63).

Regarding claim 36, Kreisel in view of Stanek does not specifically teach establishing a

set of senders and determining whether a sender of an incoming message is in the set

On the other hand, Kreisel teaches a communications package 3 includes memory

containing an incoming queue 23 and an outgoing queue 25 to store messages and/or data files

(col. 3, lines 14-26). Kreisel also teaches as shown in Fig. 4 a processing sequence including a status of newly received message (Fig. 4(204)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Kreisel's message storage as illustrated in computer system of Fig. 1b inside a modified Kreisel device for the purpose of tracking the status of each message received as taught by Kreisel (col. 3, lines 17-27).

Regarding claim 49, Kreisel teaches a method for controlling an illumination member on a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer, whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message) and changing the state associated with illumination member in response to the determining step (inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon the keyboard (15), col. 8, lines 38-46).

Kreisel does not teach changing step includes casing the illumination to change intensity.

Stanek on the other hand teaches a computer program, whereby a computer 96 instructs a keyboard controller of keyboard 98 via communications link 100 to illuminate particular keys and dim other keys (Fig. 8 (98) and col. 8, lines 14-28).

Therefore, it would have been obvious to on of ordinary skill in the art at the time the invention was made to modify Kreisel's computer system (terminal), (2) shown in Fig. 1b to adapt Stanek's computer program with respect to keyboard illumination as demonstrated in Fig. 8 because the use of a program with respect to keyboard illumination helps establish has a bi-

directional communication link between a keyboard and a computer as taught by Stanek (col. 4, lines 62-67).

4.       Claims 37-38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreisel et al. (USPN 6088516).

Regarding claim 37, Kreisel teaches a method for controlling an illumination member on a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer, whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message) and changing the state associated with illumination member in response to the determining step (inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon the keyboard (15), col. 8, lines 38-46).

Kreisel does not specifically teach establishing a set of senders and determining whether a sender of an incoming message is in the set.

On the other hand, Kreisel teaches a communications package 3 includes memory containing an incoming queue 23 and an outgoing queue 25 to store messages and/or data files (col. 3, lines 14-26). Kreisel also teaches as shown in Fig. 4 a processing sequence including a status of newly received message (Fig. 4(204)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize message storage as illustrated in computer system of Fig. 1b for the purpose of tracking the status of each message received (col. 3, lines 17-27).

Regarding claim 38, Kreisel teaches said determining step includes determining whether at least one incoming message ahs been received (col. 3, lines 14-26).

Regarding claim 40, Kreisel teaches a method for controlling an illumination member on a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer, whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message) and changing the state associated with illumination member in response to the determining step (inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon the keyboard (15), col. 8, lines 38-46).

Kreisel does not specifically teach whether a request to respond to one of a video conference call and an audio conference call has been received.

Kreisel on the other hand teaches as shown in Fig. 1a a plurality of computer terminals 2 remotely located from one another, with each of the terminals having an electronic communications package 3 or 5 installed (col. 2, lines 62-66).

It would have been obvious to one of ordinary skill in the art a the time the invention was made to utilize kreisel's network of multiple terminals (2) shown in Fig. 1a for the purpose of communicating and interacting with one another (col. 2, lines 36-38).

5.      Claims 41 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreisel et al. (USPN 6088516) in view of Pennel (USPN 6874023).

Regarding claim 41, Kreisel teaches a method for controlling an illumination member on

a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer,

whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message)

and changing the state associated with illumination member in response to the determining step

(inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon

the keyboard (15), col. 8, lines 38-46).

Kreisel does not teach whether a user is capable of receiving a solicitation.

Pennel (USPN 6874023) on the other hand teaches generation of a unique email address

for use in communicating with a web site as illustrated in Fig. 4 where a user receives email from

the web site, whether solicited or unsolicited, such that the user is able to discern the sender of

the email, as well as control future email correspondence with the web site (col. 1, lines 42-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt

Pennel's user control with respect to emails as indicated in Fig. 4 because user control over

emails helps increase convenience in managing a user's Internet communications as taught by

Pennel (col. 1, lines 42-45).


Regarding claim 50, Kreisel teaches a method for controlling an illumination member on

a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer,

whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message)

and changing the state associated with illumination member in response to the determining step

(inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon

the keyboard (15), col. 8, lines 38-46).

Kreisel does not specifically teach a determining step with respect to joining a chat room.

Kreisel on the other hand teaches as shown in Fig. 1a a plurality of computer terminals 2

remotely located from one another, with each of the terminals having an electronic

communications package 3 or 5 installed (col. 2, lines 62-66).

It would have been obvious to one of ordinary skill in the art a the time the invention was

made to utilize kreisel's network of multiple terminals (2) shown in Fig. 1a for the purpose of

communicating and interacting with one another (col. 2, lines 36-38).

Kreisel does not teach determining step including whether a request to respond to a

solicitation ahs been received.

Pennel (USPN 6874023) on the other hand teaches generation of a unique email address

for use in communicating with a web site as illustrated in Fig. 4 where a user receives email from

the web site, whether solicited or unsolicited, such that the user is able to discern the sender of

the email, as well as control future email correspondence with the web site (col. 1, lines 42-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt

Pennel's user control with respect to emails as indicated in Fig. 4 because user control over

emails helps increase convenience in managing a user's Internet communications as taught by

Pennel (col. 1, lines 42-45).

6.    Claims 42 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kreisel et al. (USPN 6088516) in view of Macko (USPN 6052563).

Regarding claim 42, Kreisel teaches a method for controlling an illumination member on

a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer,

whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message)

and changing the state associated with illumination member in response to the determining step

(inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon

the keyboard (15), col. 8, lines 38-46).

Kreisel does not teach comparing a scheduled event time relative to an actual time set in

the computer.

Macko (USPN 6052563) on the other hand teaches an email-forwarding program in a PC

130 which is activated at an appropriate time corresponding to the scheduled appointment (col. 8,

lines 56-67, col. 8, lines 1-4 and Fig. 13 (700)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt

Macko's email forwarding program (700) as configured in Fig. 13 because an email forwarding

program helps automatically forward emails to a communication device (100) as taught by

Macko.

Regarding claim 17, Macko teaches said determining step includes determining whether the actual time set in the computer is the same as the scheduled event time (col. 8, lines 56-67, col. 8, lines 1-4 and Fig. 13 (700)).

Regarding claim 18, Macko teaches said determining step includes determining whether the actual time set in the computer has reached a time prior to the scheduled event time (col. 8, lines 56-67, col. 8, lines 1-4 and Fig. 13 (700)).

7.      Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kreisel et al. (USPN 6088516) in view of Suzuki et al. (USPN 5890139).

Regarding claim 43, Kreisel teaches a method for controlling an illumination member on a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer, whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message) and changing the state associated with illumination member in response to the determining step (inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon the keyboard (15), col. 8, lines 38-46).

Kreisel does not teach determining whether a correct answer has been input.

Suzuki et al. (USPN 5890139) on the other hand teaches an information answering system in which not-yet-answered case processing unit 160 edits an input answer into the electronic mail format and transfers it to the electronic mail transmission unit 180 (Fig. 5 (109) and col. 7, lines 8-14).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt

Suzuki's answer transmission via email (109) as configured in Fig. 5 because the use of answer

transmission via email helps function online shopping as taught by Suzuki (col. 1, lines 6-7).

8.      Claims 44-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreisel et

al. (USPN 6088516) in view of Gough et al. (USPN 6360221).

Regarding claim 44, Kreisel teaches a method for controlling an illumination member on

a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer,

whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message)

and changing the state associated with illumination member in response to the determining step

(inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon

the keyboard (15), col. 8, lines 38-46).

Kreisel does not teach the determining step including one of a state, a characteristic, and

a condition relating to a character in a game program.

Gough et al. (USPN 6360221) on the other hand teaches an enhanced interactive e-mail

system implementing a chess game program, which remembers positions, enforces rules (Fig. 13,

col. 15, lines 66-67 and col. 16, lines 1-13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt

Gough's enhanced interactive email driven game as demonstrated in Fig. 13 because the use of

enhanced interactive email helps attract users and members to the website as taught by Gough

(col. 2, lines 45-49).

Regarding claim 45, Gough teaches said determining step includes determining whether

the character is within a given proximity of an object (col. 15, lines 66-67 and col. 16, lines 1-13,

enhanced e-mail implements a chess game program which remembers positions, enforces rules

etc. It would have been obvious to utilize Kreisel's email- based flashing with respect Gough's

email-based chess game program).

Regarding claim 46, Gough teaches said changing step includes the illumination member

to change states in a manner corresponding to a number of lives remaining for the character (col.

15, lines 66-67 and col. 16, lines 1-13, enhanced e-mail implements a chess game program which

remembers positions, enforces rules etc. For one of ordinary skill, it would be obvious to

reprogram Gough's chess game for additional functionalities. It would also have been obvious to

utilize Kreisel's email- based flashing with respect Gough's email-based chess game program).

Regarding claim 47, Gough teaches said changing step includes causing the illumination

member to change states in a manner corresponding to an amount of supply for the character

(col. 15, lines 66-67 and col. 16, lines 1-13, enhanced e-mail implements a chess game program

which remembers positions, enforces rules etc. For one of ordinary skill, it would be obvious to

reprogram Gough's chess game for additional functionalities. It would also have been obvious to

utilize Kreisel's email- based flashing with respect Gough's email-based chess game program).

Regarding claim 48, Gough teaches said changing step includes casing the illumination

member to change states in a manner corresponding to the character entering an area in the game

program (col. 15, lines 66-67 and col. 16, lines 1-13, enhanced e-mail implements a chess game

program which remembers positions, enforces rules etc. For one of ordinary skill, it would be

obvious to reprogram Gough's chess game for additional functionalities. It would also have been

obvious to utilize Kreisel's email- based flashing with respect Gough's email-based chess game

program).

### *Claim Rejections - 35 USC § 102*

9.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 39 is rejected under 35 U.S.C. 102(e) as being anticipated by Kreisel et al. (USPN

6088516).

Regarding claim 39, Kreisel teaches a method for controlling an illumination member on

a computer input device (col. 9, lines 18-31) said method comprising determining, in a computer,

whether a predetermined event has occurred; (Fig. 1(b) and col. 3, lines 18-21, email message)

and changing the state associated with illumination member in response to the determining step

(inform a user when new mail messages are received by flashing one of the LEDs (17, 21) upon

the keyboard (15), col. 8, lines 38-46),  wherein said determining  step includes determining step

includes determining whether an instant message has been received (Fig. 2(204) and col. 8, lines

61-66).

10.    Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Abbas I. Abdulselam whose telephone number is (571) 272-7685.

The examiner can normally be reached on Monday through Friday from 9:00 A.M. to 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Amr Awad can be reached on (571) 272-7764.  The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system.  Status information for published applications

may be obtained from either Private PAIR or Public PAIR.  Status information for unpublished

applications is available through Private PAIR only.  For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Abbas Abdulselam

Examiner

Art Unit 2677

December 9, 2005

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AMR A. AWAD
PRIMARY EXAMINER